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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,707	01/28/2004	Jared Floyd	65744/P016US/10316060	3818
29053 7590 05/14/2008 FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784				
EXAMINER MEHTA, PARIKHA SOLANKI				
ART UNIT		PAPER NUMBER		
3737				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,707

Applicant(s)

FLOYD ET AL.

Examiner

PARIKHA S. MEHTA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 1/14/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-12 and 14-38 have been considered but are moot in view of the new ground(s) of rejection.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 24, 56, 201 and 1002. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes

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are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 18, 19, 30 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the claims recite a guide having a predefined closing angle, and a closing angle which is calibrated. The present disclosure makes no discussion of a predefined and/or calibrated closing angle, and as such a skilled artisan would not be reasonably apprised of how to achieve these limitations. Furthermore, since the subject matter of claims 18, 19, 30 and 31 are so lacking in support in the accompanying disclosure, they cannot be examined further herein on the merits of their patentability over the prior art.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 and 13-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-8, claim 1 is incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: one or more medical device supports. Although supports are mentioned in the claims in relation to limitations placed on the bracket and latch, they are not actively recited as an element of the invention. It is suggested that the claim be amended to recite "a plurality of medical device supports having either a different angle of attack or different gauge" after the word "comprising:" in order to actively claim the supports.

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Furthermore, the claim recites “a latch within said support”, which is preceded by recitations of a plurality of supports. As such, it is unclear within which support the latch is located.

Further regarding claim 4, the claim states that the bracket comprises a pivot point at the proximal end of the medical device support. In claim 1, from which claim 4 depends, the medical device support and pivot point are recited to be two different structural elements. Accordingly, claim 4 is effectively reciting that the bracket further comprises a feature (a pivot point) of an entirely separate element (the support). The claim should be amended to make clear exactly which element the pivot point is located upon.

Regarding claims 9-12 and 14-15, claim 9 recites “said guide having a longitudinal seating area” where it appears the claim should more specifically recite “said support having a longitudinal seating area”.

Regarding claims 16-23, the phrase “the longitudinal axis” lacks proper antecedent basis. It is recommended that the preamble of the claim be amended to recite “a probe having a longitudinal axis” in order to overcome this rejection. Additionally, the phrase “a positioned one of said medical device” is grammatically incorrect; the phrase should be amended to read “the medical device” in order to cure this deficiency.

Regarding claims 24-38, the phrase “the proximate end” in the preamble of claim 24 lacks proper antecedent basis. It is recommended that claim 24 be amended to instead recite “a proximate end” in order to overcome this rejection. Furthermore, claim 24 recites “the longitudinal axis” without proper antecedent basis as was previously applied to claim 16. Claim 24 also recites “said bracket” without proper antecedent basis.

Additionally, it is recommended that all recitations of the word “for” in the context of structural limitations in all pending claims be replaced with language such as “configured to” or “adapted to” in order to positively recite the limitations following such a phrase. Limitations recited as being “for” a purpose are interpreted as being nothing more than intended use recitations that fail to place a positive structural limitation on the claimed invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-12, 14-17, 20-29 and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Pruter (US Patent No. 6,296,614 B1), hereinafter Pruter ('614), previously made of record.

Pruter ('614) discloses a method and system for guiding a needle while attached to an ultrasound transducer probe, wherein the guide includes a latch 22, a longitudinal and cross-sectionally round channel/guide 40 ("a longitudinal seating area") capable of accepting a needle ("medical device" or "rod"), and a latch 92 that is capable of sliding over the needle and applying controlled clamping force on the needle (Figs. 2 & 4). The present recitation of a "latch" is interpreted to constitute "any of various devices in which mating mechanical parts engage to fasten but usually not to lock something," as per the common definition of the term "latch" set forth by Merriam Webster. The system of Pruter ('614) further includes a bracket 6 that attaches to the probe (Fig. 2, col. 2 lines 37-39), wherein the bracket is adapted to accept, one at a time, a plurality of needle guides ("medical device supports") of varying gauge (col. 9 lines 1-). The apparatus of Pruter ('614) further includes slots for fitting over a transducer (Fig. 2), a flexible tab 36, a tapered wedge 38 and a pivot point at its proximal end (Examiner notes that, so long as an element can be moved in a pivotal fashion at a particular location, it is reasonably considered to have "a pivot point" at that location). Pruter ('614) further discloses the latch to include a funnel shaped body 40 and an overhang portion on the latch 92 (Fig. 4) that prevents the needle from becoming disengaged from the guide without first moving the latch to an open position, wherein the overhang constitutes pivoting means for controlling the release of the needle as claimed. Pruter ('614) sets forth steps for advancing a biopsy needle through the guide while the guide is attached to the transducer, and for separating the transducer assembly from the needle after insertion (col. 5 lines 19-34).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARIKHA S. MEHTA whose telephone number is (571)272-3248. The examiner can normally be reached on M-F, 8 - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian L Casler/

Supervisory Patent Examiner, Art Unit
3737

/Parikha S Mehta/

Examiner, Art Unit 3737